

REMARKS

The Examiner's Office Action of January 11, 2005 has been received and its contents reviewed. Applicants would like to thank the Examiner for the consideration given to the above-identified application.

By this Amendment, claims 1, 3, 6, and 7-11 have been amended, claim 2 has been canceled, and new claims 14-18 have been added for consideration. Accordingly, claims 1 and 3-18 are pending for consideration, of which claims 1, 6 and 16 are independent. By the actions above and the remarks below, Applicants respectfully request reconsideration and allowance of all the pending claims.

Referring now to the detailed Office Action, claims 6-13 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Particularly, claims 6 lacks proper antecedent basis for "said oxide film", and claims 7 and 8 lack proper antecedent basis for "said protective film." In response, Applicants have amended the claims as shown above, the change "oxide film" to "insulating film" in claim 6, and "protective film" to "insulating film" in claims 7-9 to overcome the rejection.

Claims 1-5 stand rejected under 35 U.S.C. 102(e) as anticipated by Yamazaki et al. (U.S. Patent No. 6,246,070 – hereafter Yamazaki '070). Still further, claims 1 and 3-5 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 18, 23-25 of Yamazaki '070. Still further, claim 2 stands rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claim 18 of Yamazaki '070 in view of Teramoto et al. (U.S. Patent No. 5,923,966 – hereafter Teramoto).

In response to the §102(e) rejections and obviousness-type double patenting rejections, Applicants have amended independent claim 1 to add a feature of covering a portion of the first mask and either a portion of the source region or a portion of the drain region with a second mask. This addition feature further distinguishes the presently claimed invention from that of Yamazaki '070.

In other words, Applicants amended claim 1 to further recite a second mask (e.g., 113b in Fig. 1) covering a portion of the first mask (e.g., 110b) and either a portion of the source region or a portion of the drain region (e.g., 115). On the other hand, Yamazaki '070

discloses a second mask (112) covering an entire surface of a first mask (109b) and both of a portion of a source region and a portion of a drain region (114). Yamazaki '070 appears to fail to teach "covering a portion of the first mask and either a portion of the source region or a portion of the drain region with a second mask" as recited in amended claim 1.

It appears that the Examiner did not make any rejection of independent claim 6, except for the §112, second paragraph, rejection. Nonetheless, Applicants have amended claim 6, as shown above. The arguments set forth above with respect to the rejection of independent claim 1 are also applicable to the rejection of claim 6.

Consequently, since each and every feature of the present claims is not taught (and is not inherent) in the teachings of Yamazaki '070, as is required by MPEP Chapter 2131 in order to establish anticipation, the rejection of claims 1-5, under 35 U.S.C. §102(e), as anticipated by Yamazaki '070 is improper.

Moreover, MPEP 804 (page 800-22 Aug. 2001 Edition) states the following:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

Accordingly, the burden is on the Office to establish why one of ordinary skill in the art would conclude that the invention recited in the instant claims 1, 2 and 3-5 is an obvious variant of the invention recited in claims 18, 23-25 of the Yamazaki '070 reference and of the Teramoto reference.

Applicants have amended claims 1, 3, 6, 10 and 11 to further clarify the scope of the claimed invention. Applicants have also canceled claim 2 and added new claims 14-18, of which claim 16 is independent, to further complete the scope of the invention to which Applicants are entitled.

With respect to new independent claim 16, Applicants respectfully assert that the claim is distinguished from Yamazaki '070 with the recitation of the feature of "covering a portion of a channel formation region of the semiconductor film and either a portion of a region to become a source region or a portion of a region to become a drain region of the semiconductor film with a mask".

In view of the amendments and arguments set forth above, Applicants respectfully request reconsideration and withdrawal of all the pending rejections.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise which could be eliminated through discussions with Applicants' representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,



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